REMARKS

Claims 2 and 4-11 are pending in this application. By this amendment, claim 4 is amended. No new matter is added.

Entry of the amendments to claim 4 is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments to claim 4 are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. §112 Rejections

The Office Action rejects claims 2 and 4-11 under the written description requirement of 35 U.S.C. 112, first paragraph, and under 35 U.S.C. 112, second paragraph, as being indefinite. By this Amendment, claim 4 is amended as suggested by the Office Action. As acknowledged in the Office Action, support for the amendments to claim 4 can be found at page 12. Reconsideration and withdrawal of the rejections are respectfully requested.

II. §103 Rejections

The Office Action rejects claims 2 and 4-11 under 35 U.S.C. 103(a) as being obvious over Ansell (U.S. Patent No. 5,087,686) in view of Huver (U.S. Patent No. 5,700,891) and further in view of Hatton (U.S. Patent No. 6,086,795). Applicants respectfully traverse the rejection.

Claim 4 recites:

> An adhesive material comprising a supporting layer and an adhesive polymer formed from a polymerized and cured mixture of urethane prepolymer and a dilution monomer, said adhesive polymer is impregnated into or coated onto the supporting layer, wherein the urethane prepolymer comprising a prepolymer having the following chemical formula [I]: ... wherein the dilution monomer is selected from the group consisting of decyl (meth)acrylate, dodecyl (meth)acrylate, tridecyl (meth)acrylate, isomers of these (meth)acrylates, and an isomer of octadecyl (meth)acrylate.

As admitted by the Office Action, Ansell, alone or in view of Huver, fails to teach or suggest the claimed adhesive material comprising an adhesive polymer formed from a polymerized and cured mixture of urethane prepolymer and a dilution monomer selected from the group consisting of decyl (meth)acrylate, dodecyl (meth)acrylate, tridecyl (meth)acrylate, isomers of these (meth)acrylates, and an isomer of octadecyl (meth)acrylate. Hatton is cited for disclosing an adhesive compositions containing n-octadecyl acrylate.

A. One Skilled in the Art Would Not Have Been Motivated to Combine the Teachings of Hatton with the Teachings of Ansell and Huver

The Office Action argues that one skilled in the art would have been motivated to (i) modify Ansell's curable composition to include the Huver's compound, and to (ii) further modify Ansell's composition to include "a suitable diluent monomer such as n-octadecyl acrylate, as taught by Hatton, motivated by the desire to obtain a suitable viscosity to facilitate the application of the adhesive to a substrate." However, the Office Action fails to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP §2142 and §2143. The teaching or suggestion to make the claimed combination must

be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Hatton generally discloses using reactive diluents for reducing the viscosity of adhesive compositions (col. 15, lines 36-41), and discloses n-octadecyl acrylate (col. 15, line 49) in a list of more than 35 examples of such diluents (col. 15, line 43 to col. 16, line 9). However, the Office Action fails to provide any motivation for one skilled in the art to have selected a particular diluent (such as n-octadecyl acrylate) from Hatton's list of over 35 diluents. Furthermore, in the absence of the instant specification, the Office Action fails to provide any motivation for one skilled in the art to have selected a "suitable diluent monomer," i.e., a dilution monomer selected from the group consisting of decyl (meth)acrylate, dodecyl (meth)acrylate, tridecyl (meth)acrylate, isomers of these (meth)acrylates, and an isomer of octadecyl (meth)acrylate, as required by claim 4.

B. Hatton Fails to Remedy the Deficiencies of Ansell and Huver

As discussed above, Ansell, alone or in view of Huver, fails to teach or suggest the claimed adhesive material comprising an adhesive polymer formed from a polymerized and cured mixture of urethane prepolymer and a dilution monomer selected from the group consisting of decyl (meth)acrylate, dodecyl (meth)acrylate, tridecyl (meth)acrylate, isomers of these (meth)acrylates, and an isomer of octadecyl (meth)acrylate. Hatton is cited for disclosing an adhesive compositions containing n-octadecyl acrylate. However, Hatton fails to remedy the deficiencies of Ansell and Huver.

Specifically, although Hatton discloses n-octadecyl acrylate in a list of more than 35 compounds (col. 15, line 43 to col. 16, line 9), Hatton fails to teach or suggest a dilution monomer selected from the group consisting of decyl (meth)acrylate, dodecyl (meth)acrylate, tridecyl (meth)acrylate, isomers of these (meth)acrylates, and an isomer of octadecyl (meth)acrylate.

Under IUPAC terminology, n-octadecyl acrylate is a straight-chained solid compound. When used in an adhesive composition, n-octadecyl acrylate provides the composition with excellent crystallinity. However, because n-octadecyl acrylate is a solid, it is not suitable as a dilution monomer.

In contrast to Hatton's solid n-octadecyl acrylate, the claimed dilution monomer is a liquid composition. Specifically, each of decyl (meth)acrylate, dodecyl (meth)acrylate, tridecyl (meth)acrylate, isomers of these (meth)acrylates, and an isomer of octadecyl (meth)acrylate are liquid compositions. Furthermore, an isomer of octadecyl (meth)acrylate is a branched-chain liquid, and not a straight-chained solid.

C. Conclusion

For at least these reasons, the Office Action has failed to establish a *prima facie* case of obviousness. Specifically, (i) one skilled in the art would not have been motivated to combine the teachings of Hatton with the teachings of Ansell and Huver, and (ii) Ansell, in view of Huver, and further in view of Hatton fails to teach or suggest every feature of claim 4. Accordingly, claim 4 would not have been obvious over Ansell, alone or in view of Huver and further in view of Hatton. Thus, claim 4 is patentable over Ansell, alone or in view of Huver and further in view of Hatton.

Claims 2 and 5-11 depend from claim 4 and include all of its limitations. Accordingly, these dependent claims are patentable over Ansell, alone or in view of Huver and further in view of Hatton for at least the same reasons as claim 4.

Reconsideration and withdrawal of the rejections are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 2 and 4-11 are earnestly solicited.

Should the examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the examiner is invited to contact the undersigned at the telephone number set forth below.

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JAO:PAC

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